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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/723,511	11/26/2003	Kevin W. Eberman	58581US002	8947
32692	7590	06/21/2006	EXAMINER	
3M INNOVATIVE PROPERTIES COMPANY			VANOY, TIMOTHY C	
PO BOX 33427			ART UNIT	PAPER NUMBER
ST. PAUL, MN 55133-3427			1754	

DATE MAILED: 06/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/723,511

Applicant(s)

EBERMAN ET AL.

Examiner

Timothy C. Vanoy

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 05 June 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☐ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

The person having ordinary skill in the art has the capability of understanding the scientific and engineering principles applicable to the claimed invention. The references of record in this application reasonably reflect this level of skill.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

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consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-17 are again rejected under 35 U.S.C. 103(a) as being unpatentable over U. S. Patent App'n. Pub. US 2003/0027048 A1 to Lu et al.

The Lu et al. publication in paragraph no. 0003 describes a cathode composition for a lithium ion battery of the general formula:  $\text{Li}[\text{M}^{1}_{(1-x)}\text{Mn}_x]\text{O}_2$  where  $0 < x < 1$  and  $\text{M}^1$  represents one or more metals other than chromium (examples of suitable metals include Ni, Co, Fe, Cu, Li, Zn, V and combinations thereof: please see paragraph no. 0024). The composition is in the form of a single phase having an  $\text{O}_3$  crystal structure. The Lu et al. publication is also directed to lithium ion batteries incorporating these cathode compositions in combination with an anode and an electrolyte.

Paragraph no. 0023 sets forth that the cathode composition may be synthesized by jet milling or by combining precursors of the metal elements (e. g. hydroxides, nitrates and the like), followed by heating at temperatures of at least 600 °C.

The difference between the applicants' claims and this Lu et al. publication is that Lu et al. broadly discloses that M may be at least one selected from Ni, Co, Fe, Cu, Li, Zn, V and combinations thereof whereas the applicants' claims call for M to be both Ni and Co, however it is submitted that this difference would have been obvious to one of ordinary skill in the art at the time the invention was made because the courts have already determined that such selection of a particular member out of a prior art reference's group of members is *prima facie* obvious: please see the discussion of the

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*In re Petering* 301 F.2d 676, 681, 133 USPQ 275, 280 (CCPA 1962) court decision set forth in section 2144.08(II)(A)(4)(a) in the MPEP 8<sup>th</sup> Ed, Rev. 3, Aug. 2005.

### ***Response to Arguments***

Applicants' arguments submitted with their amendment filed on June 5, 2006 have been fully considered but they are not persuasive.

a) *The applicants argue that Lu et al. uses co-precipitation of mixed metal nitrates and metal hydroxides to make single-phase four metal cathode compounds in their Examples 19 and 20. Applicants' Examples 1 and 2 show the use of wet milling to obtain single-phase four metal cathode compounds.*

The applicants' argument is not accompanied with any evidence establishing that there is a patentable difference between the "wet milling" of applicants' claim 1 and the "jet milling" set forth in paragraph no. 0023 in U. S. Pat. App'n. No. US 2003/0027048 A1 - hence, the 35USC103 rejection is maintained.

b) *The applicants argue that their Comparison Example 1 shows that when the Example 1 starting powders were dry milled, a compound exhibiting at least two phases by powder x-ray diffraction analysis was obtained. Applicants' Comparison Example 2 shows that a single phase four metal compound like that prepared in applicants' Example 1 could be made by co-precipitation of mixed metal nitrates and metal hydroxides, but that doing so required lengthy washing and drying steps which were not needed in Example 1 and Example 2.*

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The applicants' argument is not accompanied with any evidence establishing that there is a patentable difference between the "wet milling" of applicants' claim 1 and the "jet milling" set forth in paragraph no. 0023 in U. S. Pat. App'n. No. US 2003/0027048 A1 - hence, the 35USC103 rejection is maintained.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Timothy C. Vanoy whose telephone number is 571-272-8158. The examiner can normally be reached on Mon-Fri 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stanley Silverman, can be reached on 571-272-1358. The fax phone

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number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*Timothy C Vandy*  
Timothy C Vandy  
Primary Examiner  
Art Unit 1754

tv